

REMARKS

Applicant has amended claim 10. Thus, claims 10-16 are currently pending in this application and claims 17-21 are in a provisionally withdrawn status. Applicant has made the amendment in a genuine attempt to address the Examiner's concerns and to place the application in a better condition for allowance or for appeal. It is believed that these amendments do not raise new issues that would require a new search to be conducted. As such, Applicant respectfully requests that these amendments be entered.

In the Office Action, the Examiner categorized the newly added claims (claims 17-21) into two new Groups: claims 17-20 into Group II, and claim 21 into Group III. As a result, the Examiner withdrew claims 17-21 from further consideration as being directed to a non-elected invention. Applicant requests reconsideration of the restriction requirement and hereby traverses the same.

The Examiner noted that Groups I, II and III are distinct because they are "related as product and process of use". Applicant is confused by this statement. Applicant submits that all pending claims 10-21 are product claims (i.e., optical spectrometer product) and **not process of use** claims. Applicant notes that all of the independent claims are directed to "an optical spectrometer" which is a product and not a process.

The Examiner then asserted that in the instant case, invention II can be used as a filter in WDM system rather than a mere optical spectrometer in Group inventions I or II. Applicant is even more confused by this assertion. Claim 17

in Group II is clearly directed to "An optical spectrometer". Claim 17 does not recite "a filter" anywhere.

Moreover, the MPEP Section 806.05(h) cited by the Examiner only applies to a situation where a single application contains both product and method claims. The "Examiner Note" section immediately following Section 806.05(h) explicitly states "This form paragraph is to be used when claims are presented to both the product and process of using the product". In the instant case, there are no "process of using the product" claims. Thus, Applicant submits that Section 806.05(h) does not apply in the instant application. Withdrawal of the restriction requirement is respectfully requested.

In the Office Action, the Examiner objected to the phrase "spatial wavelength selection of spatially separated wavelengths" in claim 10 because it is not referenced in any place in the specification. Applicant submits that there is no requirement that a particular phrase must be recited verbatim in the specification. As the MPEP noted in Section 2163.07 (I), mere rephrasing of a passage does not constitute new matter. In the present application, the phrase simply means that the exit slit receives wavelengths that have been separated in space by, for example, a diffraction grating as fully disclosed at page 7, line 25 - page 8, line 18.

In the Office Action, the Examiner rejected claims 10 and 15 under 35 U.S.C. Section 102(e) as being anticipated by Warrts (US Patent No. 6,081,369). Although claims 10 and 15 have been amended, Applicant respectfully traverses the rejection to the extent that the rejection applies to the amended claims.

Claim 10 has been amended to recite an optical reflection grating for diffracting wavelengths of light to make it clear that the spatially separated light relates to diffracted light.

The Examiner stated that Waarts teaches "spatial wavelength selection of spatially separated wavelengths" at col. 19, line 35. Applicant disagrees. In col. 19, lines 35-42, Waarts discloses a beam splitter 148 to split the laser intensity in a first beam for the detector 150 and a second beam for feedback controlling a laser diode device 140.

A beam splitter does not diffract light as claimed in claim 10. As Waarts does not have any diffraction element such as a reflection grating, all wavelengths lambda 1 to lambda 4 generated by laser diode device 140 are input in the light waveguide without any wavelength selection.

Claim 15 is also patentable by virtue of its dependency from parent claim 10.

The Examiner rejected claims 11-13 and 16 under 35 U.S.C. Section 103(a) as being obvious over Waarts in view of Korn (US Patent No. 6,304,688). The Examiner also rejected claim 14 under 35 U.S.C. Section 103(a) as being obvious over Warrts in view of Korn and further in view of Noell (US Patent No. 5,966,482).

Applicant submits that claims 11-14 and 16 are patentable by virtue of their dependency from independent claim 10.

Regarding claims 17-21, which stand as withdrawn by the Examiner, Applicant respectfully requests reconsideration

of the restriction requirement. If the restriction requirement is withdrawn, Applicant is willing to add "a diffraction device operable to diffract wavelengths of light" into Claims 17-21.

Based upon the above amendments and remarks, Applicant respectfully requests reconsideration of this application and its early allowance. Should the Examiner feel that a telephone conference with Applicant's attorney would expedite prosecution of this application, the Examiner is urged to contact him at the number indicated below.

Respectfully submitted,

Kerry Allen (Reg. No. 40,243)
For Eugene LeDonne
Attorney for Applicant
Reg. No. 35,930

Reed Smith LLP
599 Lexington Avenue
New York, New York 10022
Telephone No. 212-521-5400